

In the Drawings:

Replacement drawings of Figures 9 to 11 (3 sheets) are filed herewith in which graphs have been properly labelled. Copies of the original drawings (3 sheets) are enclosed for the Examiner's convenience.

REMARKS

The figures have been amended to describe the graph shown.

The claims have been revised to overcome the informalities noted by the Examiner.

The Examiner has rejected Claim 1 under 35 U.S.C.103 based on a combination of Vanka with Montojo.

Three criteria must be satisfied in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. See MPEP §706.02(j), citing *In re Vaack*, 20 USPQ2d 1438 (Fed. Cir. 1991).

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch* 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (reversing an obviousness rejection where there was no suggestion to modify a prior art mower strip to make it entirely flexible as required by applicant's claims on a flexible landscape edging strip); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984).

Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

On meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Both the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on the applicant's disclosure. See *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." See, e.g. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Examiner fails to establish a prima facie case as required by the above. In discussing the matter, the Examiner merely states on page 5 at the end of the first paragraph that "*Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the multi-carrier QAM method of Vankka with the delaying of Montojo et al since Montojo et al states the delaying of the carriers reduces peak to average power ratios.*"

However Vankka makes no statement nor even any suggestion that it is desirable to reduce peak to average ratios in a composite QAM signal and

certainly does not suggest that this could be done using the technique of Montojo.

Montojo makes no mention of QAM signals nor any desirability of reduce peak to average ratios in a composite QAM signal. While Montojo provides a technique for reducing peak to average power ratio in a multi carrier signal, there is no specific mention of QAM signals.

There is therefore simply no motivation for these references to be combined as proposed by the Examiner.

It is submitted therefore that the Examiner has failed to establish a prima facie case as required in MPEP and that the rejection should be withdrawn.

The further references cited do not address this issue of motivation for the combination and thus are irrelevant to the patentability of Claim 1.

It is submitted that Claims 2 to 6 are dependent on an allowable Claim 1 and thus should be allowed therewith.

Respectfully submitted

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Enc.(6)

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